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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

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| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | Application Number | 09/264,762 | |
| | Filing Date | March 9, 1999 | |
| | First Named Inventor | Jurmain | |
| | Art Unit | 3714 | |
| | Examiner Name | John Sotomayor | |
| Total Number of Pages in This Submission | 26 | Attorney Docket Number | BTO019USPT01 |

ENCLOSURES (Check all that apply)

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|---|--|--|
| <input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance communication to Technology Center (TC) <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below): <div>RECEIVED FEB 10 2004 TECHNOLOGY CENTER R3700</div> |
| Remarks Supplemental Appeal Brief is being submitted in triplicate. | | |

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | |
|-------------------------|---|
| Firm or Individual name | Michael S. Sherrill Sherrill Law Offices, PLLC |
| Signature | <i>M. Sherrill</i> |
| Date | January 30, 2004 |

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| Typed or printed name | Sharon E. Bloomquist | | |
| Signature | <i>Sharon E. Bloomquist</i> | Date | January 30, 2004 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Sharon E Bloomquist
Sharon E. Bloomquist

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| SUPPLEMENTAL APPEAL BRIEF | | | Docket No. BTO019USPT01 |
| Serial No. 09/264,762 | Filing Date March 9, 1999 | Examiner John Sotomayor | Group Art Unit 3714 |
| Applicant: | Jurmain | | |
| Invention: | DEVICE FOR SIMULATING SOME ASPECTS OF CIGARETTE USE | | |

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Alexandria, Virginia 22313-1450

Dear Sir:

This supplemental brief is filed on appeal from the decision of the Examiner mailed October 30, 2003 finally rejecting pending claims 1-4, 6-30 and 32-42 in the above-referenced patent application.

This brief is being submitted in triplicate in accordance with 35 C.F.R. 1.192(a). The filing fee under 35 C.F.R. 1.17(c) was paid in connection with the original Appeal Brief.

REAL PARTY IN INTEREST

Unchanged from Replacement Appeal Brief.

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RELATED APPEALS AND INTERFERENCES

Unchanged from Replacement Appeal Brief.

STATUS OF CLAIMS

The application was filed on March 9, 1999. The application was originally filed with claims 1-42. Claims 1, 12, 27, 28, 32, 35-37 and 39 were amended and claim 31 canceled in an Amendment & Response mailed on September 30, 2002. Claims 1-30 and 32-42 remain pending in the application. No claims have been allowed.

The rejection of claims 1-4, 6-30 and 32-42 is appealed. A copy of the claims involved in this appeal was provided in the Appendix section of the Replacement Brief in accordance with 37 C.F.R. 1.192(c)(9).

STATUS OF AMENDMENTS

Unchanged from Replacement Appeal Brief.

SUMMARY OF THE INVENTION

Unchanged from Replacement Appeal Brief.

ISSUES

1. Whether claims 1, 2, and 4 are anticipated by Bonnett (United States Patent No. 4,138,722).
2. Whether claims 22-24 are anticipated by Schneier et al. (United States Patent No. 5,871,398).

3. Whether claims 3, 6 and 8-10 are obvious over Bonnett (United States Patent No. 4,138,722) in view of Schneier et al. (United States Patent No. 5,871,398).

4. Whether claims 7 and 11 are obvious over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,913,310).

5. Whether claims 12-21, 33, 34 and 37 are obvious over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,918,603) and further in view of Schneier et al. (United States Patent No. 5,871,398).

6. Whether claim 25 is obvious over Schneier et al. (United States Patent No. 5,871,398) in view of Bonnett (United States Patent No. 4,138,722).

7. Whether claim 26 is obvious over Schneier et al. (United States Patent No. 5,871,398) in view of Brown (United States Patent No. 5,913,310).

8. Whether claims 27, 28 and 30 are obvious over Schneier et al. (United States Patent No. 5,871,398) in view of Brown (United States Patent No. 5,913,310) in further view of Hillsman (United States Patent No. 4,984,158).

9. Whether claims 29 and 32 are obvious over Schneier et al. (United States Patent No. 5,871,398) in view of Brown (United States Patent No. 5,918,603) in further view of Hillsman (United States Patent No. 4,984,158) and Bonnett (United States Patent No. 4,138,722).

10. Whether claims 35, 36 and 38-42 are obvious over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,918,603) and further in view of Schneier et al. (United States Patent No. 5,871,398) and Knight et al. (United States Patent No. 5,676,551).

GROUPING OF CLAIMS

1. Rejected claims 1, 2, and 4 stand or fall together with respect to the anticipation rejection of these claims over Bonnett (United States Patent No. 4,138,722).

2. Rejected claims 22-24 stand or fall together with respect to the anticipation rejection of these claims over Schneier et al. (United States Patent No. 5,871,398).

3. Rejected claims 3, 6 and 8-10 stand or fall together with respect to the obviousness rejection of these claims over Bonnett (United States Patent No. 4,138,722) in view of Schneier et al. (United States Patent No. 5,871,398).

4. Rejected claims 7 and 11 stand or fall together with respect to the obviousness rejection of these claims over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,913,310).

5. Rejected claims 12-21, 33, 34 and 37 do not stand or fall together with respect to the obviousness rejection of these claims over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,918,603) and further in view of Schneier et al. (United States Patent No. 5,871,398). Rejected claims 12-21 stand or fall together as a group with respect to this rejection. Claims 33, 34 and 37 stand or fall together as a separate group with respect to this rejection..

6. The rejection of claim 25 is obvious over Schneier et al. (United States Patent No. 5,871,398) in view of Bonnett (United States Patent No. 4,138,722) pertains to a single claim.

7. The rejection of claim 26 is obvious over Schneier et al. (United States Patent No. 5,871,398) in view of Brown (United States Patent No. 5,913,310) pertains to a single claim.

8. Rejected claims 27, 28 and 30 stand or fall together with respect to the obviousness rejection of these claims over Schneier et al. (United States Patent No. 5,871,398) in

view of Brown (United States Patent No. 5,913,310) in further view of Hillsman (United States Patent No. 4,984,158).

9. Rejected claims 29 and 32 stand or fall together with respect to the obviousness rejection of these claims over Schneier et al. (United States Patent No. 5,871,398) in view of Brown (United States Patent No. 5,918,603) in further view of Hillsman (United States Patent No. 4,984,158) and Bonnett (United States Patent No. 4,138,722).

10. Rejected claims 35, 36 and 38-42 stand or fall together with respect to the obviousness rejection of these claims over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,918,603) and further in view of Schneier et al. (United States Patent No. 5,871,398) and Knight et al. (United States Patent No. 5,676,551).

ARGUMENT

Objections/Rejections Under 35 U.S.C. §§ 102 or 103

1.0 *The Examiner has rejected claims 1, 2, and 4 as anticipated by Bonnett (United States Patent No. 4,138,722).*

SUMMARY OF CITED REFERENCE

Bonnett discloses a device for automatically counting the number of times a smoker inhales upon a tobacco product, such as a cigarette. The device includes a pocket calculator, a pressure sensitive switch and a cigarette holder. The pressure sensitive switch is in fluid communication with the internal chamber of the cigarette holder for detecting a decrease in pressure within the holder caused by a smoker inhaling upon a cigarette positioned within the holder. The pressure sensitive switch is in electrical communication with the pocket calculator for summing and visually displaying the number of detected inhalations.

SUMMARY OF CLAIMED INVENTION

The First Embodiment of the Claimed Invention (claims 1-11) is directed to an addiction simulator for education about and deterrence of drug use. The simulator includes (i) an enclosure, (ii) an electronic circuit housed within the enclosure, (iii) an actuator electrically interconnected to the electronic circuit, and (iv) a pushbutton switch responsive to an activity of a user of the addiction simulator which simulates participation in an addictive activity involving drug use.

LEGAL BASIS FOR ESTABLISHING ANTICIPATION

An anticipation rejection under 35 U.S.C. §102 requires that the cited reference(s) disclose each and every element of the claimed invention. See, Hybritech Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); Kloster Speedsteel AB et al. v. Crucible Inc. et al., 230 U.S.P.Q. 81, 84 (Fed. Cir. 1986). Accordingly, the “exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference.” Atlas Powder Co. v. E.L duPont De Nemours & Co., 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

BONNETT DOES NOT DISCLOSE EACH AND EVERY ELEMENT OF THE CLAIMED INVENTION

The Claimed Invention includes a pushbutton switch responsive to an activity of a user which simulates participation in an addictive activity involving drug use (*e.g.*, inhaling upon a straw simulating smoking of a cigarette). Bonnett discloses an invention which includes a pressure-sensitive switch responsive to actual smoking of a cigarette. Without an actual cigarette positioned within the cigarette holder, inhalation on the cigarette holder will not be detected by the pressure switch as the internal chamber of the cigarette holder is open to the atmosphere and a vacuum cannot be created within the holder.

2.0 *The Examiner has rejected claims 22-24 as anticipated by Schneier et al. (United States Patent No. 5,871,398).*

SUMMARY OF CITED REFERENCE

Schneier discloses a hand-held, off-line remote gambling system. The device includes a case, a power source, a programmable electronic circuit powered by the power source, a programmable sound synthesizer, and communications ports. The communications ports permit connection to a modem [158], a bar code scanner [152], a printer interface [150a] and printer [150b], a plug-in card interface [154] and a read/write interface [156].

SUMMARY OF CLAIMED INVENTION

A Third Embodiment of the Claimed Invention (claims 22-30 and 32) is directed to an entertainment device including (i) a case, (ii) a power source, (iii) a programmable electronic circuit powered by the power source, (iv) a voice synthesizer electrically interconnected to the programmable electronic circuit for issuing spoken prompts and taunts to a user of the entertainment device, and (v) a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information.

LEGAL BASIS FOR ESTABLISHING ANTICIPATION

An anticipation rejection under 35 U.S.C. §102 requires that the cited reference(s) disclose each and every element of the claimed invention. See, Hybritech Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); Kloster Speedsteel AB et al. v. Crucible Inc. et al., 230 U.S.P.Q. 81, 84 (Fed. Cir. 1986). Accordingly, the “exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference.” Atlas Powder Co. v. E.L duPont De Nemours & Co., 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

SCHNEIER DOES NOT DISCLOSE
EACH AND EVERY ELEMENT OF THE CLAIMED INVENTION

The Third Embodiment of the Claimed Invention includes a voice synthesizer for issuing spoken prompts and taunts to a user of the entertainment device. Schneier discloses a sound synthesizer, but does NOT disclose a voice synthesizer for issuing spoken prompts and taunts to a user of the entertainment device. Schneier discloses use of the sound synthesizer to generate game sounds (*e.g.*, dings and bells).

The Third Embodiment of the Claimed Invention further includes a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information. Schneier discloses a variety of communications ports for permitting the gaming device to communicate with a variety of peripherals, but does NOT disclose a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information.

3.0 *The Examiner has rejected claims 3, 6 and 8-10 as obvious over Bonnett (United States Patent No. 4,138,722) in view of Schneier et al. (United States Patent No. 5,871,398).*

SUMMARY OF CITED REFERENCES

Bonnett discloses a device for automatically counting the number of times a smoker inhales upon a tobacco product, such as a cigarette. The device includes a pocket calculator, a pressure sensitive switch and a cigarette holder. The pressure sensitive switch is in fluid communication with the internal chamber of the cigarette holder for detecting a decrease in pressure within the holder caused by a smoker inhaling upon a cigarette positioned within the holder. The pressure sensitive switch is in electrical communication with the pocket calculator for summing and visually displaying the number of detected inhalations.

Schneier discloses a hand-held, off-line remote gambling system. The device includes a case, a power source, a programmable electronic circuit powered by the power source, a programmable sound synthesizer, and communications ports. The communications ports permit

connection to a modem [158], a bar code scanner [152], a printer interface [150a] and printer [150b], a plug-in card interface [154] and a read/write interface [156].

SUMMARY OF CLAIMED INVENTION

A First Embodiment of the Claimed Invention (claims 1-11) is directed to an addiction simulator for education about and deterrence of drug use. The simulator includes (i) an enclosure, (ii) an electronic circuit housed within the enclosure, (iii) an actuator electrically interconnected to the electronic circuit, and (iv) a pushbutton switch responsive to an activity of a user of the addiction simulator which simulates participation in an addictive activity involving drug use.

LEGAL BASIS FOR ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See*, M.P.E.P. § 2143.

PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL OF THE CLAIM LIMITATIONS OF THE CLAIMED INVENTION.

The First Embodiment of the Claimed Invention includes a pushbutton switch responsive to an activity of a user which simulates participation in an addictive activity involving drug use (e.g., inhaling upon a straw simulating smoking of a cigarette). Bonnett discloses an invention which includes a pushbutton switch responsive to actual smoking of a cigarette. Without an actual cigarette positioned within the cigarette holder, inhalation on the cigarette holder will not

be detected by the pressure switch as the internal chamber of the cigarette holder is open to the atmosphere and a vacuum cannot be created within the holder. Schneier discloses nothing which could be equated to a pushbutton switch responsive to an activity of a user which simulates participation in an addictive activity involving drug use.

4.0 *The Examiner has rejected claims 7 and 11 as obvious over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,913,310).*

SUMMARY OF CITED REFERENCES

Bonnett discloses a device for automatically counting the number of times a smoker inhales upon a tobacco product, such as a cigarette. The device includes a pocket calculator, a pressure sensitive switch and a cigarette holder. The pressure sensitive switch is in fluid communication with the internal chamber of the cigarette holder for detecting a decrease in pressure within the holder caused by a smoker inhaling upon a cigarette positioned within the holder. The pressure sensitive switch is in electrical communication with the pocket calculator for summing and visually displaying the number of detected inhalations.

Brown (310) discloses a video game system (such as a GAME BOY) programmed with a game which requires user interaction. Monitoring and review of a medical patient's interaction with the video game permits a health care professional to diagnose and treat the patient's medical condition. The video game system includes a case, an electronic circuit housed within the case, an input device such as a series of pushbuttons, memory, a communications system such as a modem, a sound generator and a speaker for emitting sounds associated with video games (*e.g.*, dings, bells, synthesized speech, tones and tunes).

SUMMARY OF CLAIMED INVENTION

A Second Embodiment of the Claimed Invention (claims 12-21) is directed to a portable personality simulator for achieving behavior modification and education of a user of the simulator. The simulator includes (i) a case, (ii) an electronic circuit housed within the case, and

(iii) a speaker housed within the case and electrically interconnected to the electronic circuit for emitting spoken words commanding a user to behave in a desired manner.

LEGAL BASIS FOR ESTABLISHING
A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See*, M.P.E.P. § 2143.

PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL OF THE
CLAIM LIMITATIONS OF THE CLAIMED INVENTION.

The Second Embodiment of the Claimed Invention includes a speaker for emitting spoken words commanding a user to behave in a desired manner. Bonnett does not disclose a speaker. Brown (310) discloses a speaker for emitting sounds associated with video games (*e.g.*, dings, bells, speech, tones and tunes), but does NOT disclose emitting spoken words commanding a user to behave in a desired manner. Brown (310) does disclose at column 11, lines 48-59 that the video game system can emit synthesized speech. However, Brown (310) does not specify the nature of such synthesized speech, such as whether the synthesized speech is a short exclamatory statement a brief declaratory statement, a question, a comand, etc. Since video games, such as the SUPER NINTENDO™ and GAME BOY™ systems referenced in Brown (310), generate only simplistic dings, bells, tones, tunes and short incoherent exclamatory statements (*e.g.*, sounds approximating WOW!, OOOH!, AAH!, OOPS, YIPP!, etc.), those skilled in the art are NOT taught by Brown (310) to command a user to behave in a desired manner via audible speech.

5.0 The Examiner has rejected claims 12-21, 33, 34 and 37 as obvious over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,918,603) in further view of Schneier et al. (United States Patent No. 5,871,398).

SUMMARY OF CITED REFERENCES

Bonnett discloses a device for automatically counting the number of times a smoker inhales upon a tobacco product, such as a cigarette. The device includes a pocket calculator, a pressure sensitive switch and a cigarette holder. The pressure sensitive switch is in fluid communication with the internal chamber of the cigarette holder for detecting a decrease in pressure within the holder caused by a smoker inhaling upon a cigarette positioned within the holder. The pressure sensitive switch is in electrical communication with the pocket calculator for summing and visually displaying the number of detected inhalations.

Brown (603) discloses a video game system programmed with a game which provides a medical patient with therapeutic treatment and/or information for the patient's medical condition. The video game includes a case, an electronic circuit housed within the case, and a speaker for emitting sounds associated with video games (*e.g.*, dings, bells, tones and tunes). Brown (603) further discloses at column 7, lines 10-16 that characters depicted in the video game can communicate instructions and strategies to the patient, but does not specify whether such communication is audible or visual.

Schneier discloses a hand-held, off-line remote gambling system. The device includes a case, a power source, a programmable electronic circuit powered by the power source, a programmable sound synthesizer, and communications ports. The communications ports permit connection to a modem [158], a bar code scanner [152], a printer interface [150a] and printer [150b], a plug-in card interface [154] and a read/write interface [156].

SUMMARY OF CLAIMED INVENTION

A Second Embodiment of the Claimed Invention (claims 12-21) is directed to a portable personality simulator for achieving behavior modification and education of a user of the

simulator. The simulator includes (i) a case, (ii) an electronic circuit housed within the case, and (iii) a speaker housed within the case and electrically interconnected to the electronic circuit for emitting spoken words commanding a user to behave in a desired manner.

A Fourth Embodiment of the Claimed Invention (claims 33-42) is directed to a portable personality simulator including (i) a case, (ii) a programmable electronic circuit housed within the case, and (iv) a speech synthesizer electrically interconnected to the programmable electronic circuit for issuing commands simulating a particular type of personality.

LEGAL BASIS FOR ESTABLISHING
A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See, M.P.E.P. § 2143.

PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL OF THE
CLAIM LIMITATIONS OF THE CLAIMED INVENTION.

SECOND EMBODIMENT

The Second Embodiment of the Claimed Invention includes a speaker for emitting spoken words commanding a user to behave in a desired manner. Bonnett does not disclose a speaker. Brown (603) discloses a speaker for emitting sounds associated with video games (e.g., dings, bells, tones and tunes), but does NOT disclose emitting spoken words commanding a user to behave in a desired manner. Brown (603) does disclose at column 7, lines 10-16 that characters depicted in the video game can communicate instructions and strategies to the patient.

However, Brown (603) does not specify whether such communication is audible or visual. Brown (603) discloses at column 4, lines 5-7 that the speaker is effective for "... producing sounds associated with video games ...". Since video games, such as the SUPER NINTENDO™ system referenced in Brown (603), generate only simplistic dings, bells, tones and tunes and do NOT generate speech, those skilled in the art are taught by Brown (603) to communicate instructions and strategies by a visual display and NOT by audible speech. Schneier discloses a sound synthesizer, but does NOT disclose a speaker for emitting spoken words commanding a user to behave in a desired manner. Schneier discloses use of the sound synthesizer to generate game sounds (e.g., dings and bells).

FOURTH EMBODIMENT

The Fourth Embodiment of the Claimed Invention includes a speech synthesizer for issuing commands simulating a particular type of personality. Bonnett, Brown (603) and Schneier do not disclose a speech synthesizer for issuing commands simulating a particular type of personality. Bonnett is silent as to a speech synthesizer. Brown (603) discloses a speaker for emitting sounds associated with video games (e.g., dings, bells, tones and tunes), but does NOT disclose a speech synthesizer for issuing commands simulating a particular type of personality. Brown (603) does disclose at column 7, lines 10-16 that characters depicted in the video game can communicate instructions and strategies to the patient. However, Brown (603) does not specify whether such communication is audible or visual. Brown (603) discloses at column 4, lines 5-7 that the speaker is effective for "... producing sounds associated with video games ...". Since video games, such as the SUPER NINTENDO™ system referenced in Brown (603), generate only simplistic dings, bells, tones and tunes and do NOT generate speech, those skilled in the art are taught by Brown (603) to communicate instructions and strategies by a visual display and NOT by audible speech. Schneier discloses only a sound synthesizer for generating game sounds (e.g., dings and bells).

SUMMARY OF PATENTABLE DISTINCTION BETWEEN VARIOUS EMBODIMENTS OF THE CLAIMED INVENTION

The Second Embodiment of the Claimed Invention is patentable over the cited references as it includes a speaker for emitting spoken words commanding a user to behave in a desired manner. The Fourth Embodiment of the Claimed Invention is patentable over the cited references as it includes a speech synthesizer for issuing commands simulating a particular type of personality.

6.0 *The Examiner has rejected claim 25 as obvious over Schneier et al. (United States Patent No. 5,871,398) in view of Bonnett (United States Patent No. 4,138,722).*

SUMMARY OF CITED REFERENCES

Schneier discloses a hand-held, off-line remote gambling system. The device includes a case, a power source, a programmable electronic circuit powered by the power source, a programmable sound synthesizer, and communications ports. The communications ports permit connection to a modem [158], a bar code scanner [152], a printer interface [150a] and printer [150b], a plug-in card interface [154] and a read/write interface [156].

Bonnett discloses a device for automatically counting the number of times a smoker inhales upon a tobacco product, such as a cigarette. The device includes a pocket calculator, a pressure sensitive switch and a cigarette holder. The pressure sensitive switch is in fluid communication with the internal chamber of the cigarette holder for detecting a decrease in pressure within the holder caused by a smoker inhaling upon a cigarette positioned within the holder. The pressure sensitive switch is in electrical communication with the pocket calculator for summing and visually displaying the number of detected inhalations.

SUMMARY OF CLAIMED INVENTION

A Third Embodiment of the Claimed Invention (claims 22-30 and 32) is directed to an entertainment device including (i) a case, (ii) a power source, (iii) a programmable electronic

circuit powered by the power source, (iv) a voice synthesizer electrically interconnected to the programmable electronic circuit for issuing spoken prompts and taunts to a user of the entertainment device, and (v) a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information.

LEGAL BASIS FOR ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See*, M.P.E.P. § 2143.

PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL OF THE CLAIM LIMITATIONS OF THE CLAIMED INVENTION.

The Third Embodiment of the Claimed Invention includes a voice synthesizer for issuing spoken prompts and taunts to a user of the entertainment device. Schneier discloses a sound synthesizer, but does NOT disclose a voice synthesizer for issuing spoken prompts and taunts to a user of the entertainment device. Schneier discloses use of the sound synthesizer to generate game sounds (*e.g.*, dings and bells). Bonnett does not disclose generation of any sounds.

7.0 *The Examiner has rejected claim 26 as obvious over Schneier et al. (United States Patent No. 5,871,398) in view of Brown (United States Patent No. 5,918,310).*

SUMMARY OF CITED REFERENCES

Schneier discloses a hand-held, off-line remote gambling system. The device includes a case, a power source, a programmable electronic circuit powered by the power source, a

programmable sound synthesizer, and communications ports. The communications ports permit connection to a modem [158], a bar code scanner [152], a printer interface [150a] and printer [150b], a plug-in card interface [154] and a read/write interface [156].

Brown (310) discloses a video game system (such as a GAME BOY) programmed with a game which requires user interaction. Monitoring and review of a medical patient's interaction with the video game permits a health care professional to diagnose and treat the patient's medical condition. The video game system includes a case, an electronic circuit housed within the case, an input device such as a series of pushbuttons, memory, a communications system such as a modem, a sound generator and a speaker for emitting sounds associated with video games (*e.g.*, dings, bells, synthesized speech, tones and tunes).

SUMMARY OF CLAIMED INVENTION

A Third Embodiment of the Claimed Invention (claims 22-30 and 32) is directed to an entertainment device including (i) a case, (ii) a power source, (iii) a programmable electronic circuit powered by the power source, (iv) a voice synthesizer electrically interconnected to the programmable electronic circuit for issuing spoken prompts and taunts to a user of the entertainment device, and (v) a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information.

LEGAL BASIS FOR ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See*, M.P.E.P. § 2143.

PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL OF THE
CLAIM LIMITATIONS OF THE CLAIMED INVENTION.

The Third Embodiment of the Claimed Invention includes a voice synthesizer for issuing spoken prompts and taunts to a user of the entertainment device. Schneier discloses use of a sound synthesizer to generate game sounds (*e.g.*, dings and bells). Similarly, Brown (310) discloses a speaker for emitting sounds associated with video games (*e.g.*, dings, bells, speech, tones and tunes), but does NOT disclose emitting spoken words commanding a user to behave in a desired manner. Brown (310) does disclose at column 11, lines 48-59 that the video game system can emit synthesized speech. However, Brown (310) does not specify the nature of such synthesized speech, such as whether the synthesized speech is a short exclamatory statement a brief declaratory statement, a question, a comand, etc. Since video games, such as the SUPER NINTENDO™ and GAME BOY™ systems referenced in Brown (310), generate only simplistic dings, bells, tones, tunes and short incoherent exclamatory statements (*e.g.*, sounds approximating WOW!, OOOH!, AAH!, OOPS, YIPP!, etc.), those skilled in the art are NOT taught by Brown (310) to command a user to behave in a desired manner via audible speech.

8.0 *The Examiner has rejected claims 27, 28 and 30 as obvious over Schneier et al. (United States Patent No. 5,871,398) in view of Brown (United States Patent No. 5,913,310) in further view of Hillsman (United States Patent No. 4,984,158).*

SUMMARY OF CITED REFERENCES

Schneier discloses a hand-held, off-line remote gambling system. The device includes a case, a power source, a programmable electronic circuit powered by the power source, a programmable sound synthesizer, and communications ports. The communications ports permit connection to a modem [158], a bar code scanner [152], a printer interface [150a] and printer [150b], a plug-in card interface [154] and a read/write interface [156].

Brown (310) discloses a video game system (such as a GAME BOY) programmed with a game which requires user interaction. Monitoring and review of a medical patient's interaction with the video game permits a health care professional to diagnose and treat the patient's medical

condition. The video game system includes a case, an electronic circuit housed within the case, an input device such as a series of pushbuttons, memory, a communications system such as a modem, a sound generator and a speaker for emitting sounds associated with video games (*e.g.*, dings, bells, synthesized speech, tones and tunes).

Hillsman discloses a biofeedback training and evaluation system for instructing a patient on the proper techniques of inhalation to administer aerosol drugs with a metered dose inhaler. The biofeedback system includes (i) a microprocessor, (ii) a speaker for issuing auditory prompts to the user, and (iii) communications ports. The communications ports permit connection to monitors [8] and [10], a floppy or hard disk [17], a printer [20] and a keyboard [16].

SUMMARY OF CLAIMED INVENTION

A Third Embodiment of the Claimed Invention (claims 22-30 and 32) is directed to an entertainment device including (i) a case, (ii) a power source, (iii) a programmable electronic circuit powered by the power source, (iv) a voice synthesizer electrically interconnected to the programmable electronic circuit for issuing spoken prompts and taunts to a user of the entertainment device, and (v) a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information.

LEGAL BASIS FOR ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See*, M.P.E.P. § 2143.

PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL OF THE CLAIM LIMITATIONS OF THE CLAIMED INVENTION.

The Third Embodiment of the Claimed Invention includes a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information. Schneier discloses a variety of communications ports for permitting the gambling system to communicate with a variety of peripherals, but does NOT disclose a communications port permitting interconnection of the gambling system with another gambling system for exchanging programmed information. Brown (310) discloses a communications system, such as a modem, but does NOT disclose a communications port permitting interconnection of the video game system with another video game system for exchanging programmed information. Hillsman, as with Schneier, discloses a variety of communications ports for permitting the biofeedback training and evaluation system to communicate with a variety of peripherals, but does NOT disclose a communications port permitting interconnection of the biofeedback system to another biofeedback system for exchanging programmed information.

9.0 *The Examiner has rejected claims 29 and 32 as obvious over Schneier et al. (United States Patent No. 5,871,398) in view of Brown (United States Patent No. 5,918,603) in further view of Hillsman (United States Patent No. 4,984,158) and Bonnett (United States Patent No. 4,138,722).*

SUMMARY OF CITED REFERENCES

Schneier discloses a hand-held, off-line remote gambling system. The device includes a case, a power source, a programmable electronic circuit powered by the power source, a programmable sound synthesizer, and communications ports. The communications ports permit connection to a modem [158], a bar code scanner [152], a printer interface [150a] and printer [150b], a plug-in card interface [154] and a read/write interface [156].

Brown (603) discloses a video game system programmed with a game which provides a medical patient with therapeutic treatment and/or information for the patient's medical condition. The video game includes a case, an electronic circuit housed within the case, and a speaker for

emitting sounds associated with video games (e.g., dings, bells, tones and tunes). Brown (603) further discloses at column 7, lines 10-16 that characters depicted in the video game can communicate instructions and strategies to the patient, but does not specify whether such communication is audible or visual.

Hillsman discloses a biofeedback training and evaluation system for instructing a patient on the proper techniques of inhalation to administer aerosol drugs with a metered dose inhaler. The biofeedback system includes (i) a microprocessor, (ii) a speaker for issuing auditory prompts to the user, and (iii) communications ports. The communications ports permit connection to monitors [8] and [10], a floppy or hard disk [17], a printer [20] and a keyboard [16].

Bonnett discloses a device for automatically counting the number of times a smoker inhales upon a tobacco product, such as a cigarette. The device includes a pocket calculator, a pressure sensitive switch and a cigarette holder. The pressure sensitive switch is in fluid communication with the internal chamber of the cigarette holder for detecting a decrease in pressure within the holder caused by a smoker inhaling upon a cigarette positioned within the holder. The pressure sensitive switch is in electrical communication with the pocket calculator for summing and visually displaying the number of detected inhalations.

SUMMARY OF CLAIMED INVENTION

A Third Embodiment of the Claimed Invention (claims 22-30 and 32) is directed to an entertainment device including (i) a case, (ii) a power source, (iii) a programmable electronic circuit powered by the power source, (iv) a voice synthesizer electrically interconnected to the programmable electronic circuit for issuing spoken prompts and taunts to a user of the entertainment device, and (v) a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information.

LEGAL BASIS FOR ESTABLISHING
A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See, M.P.E.P. § 2143.

PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL OF THE
CLAIM LIMITATIONS OF THE CLAIMED INVENTION.

The Third Embodiment of the Claimed Invention includes a communications port permitting interconnection of the entertainment device to another entertainment device for exchanging programmed information. Schneier discloses a variety of communications ports for permitting the gambling system to communicate with a variety of peripherals, but does NOT disclose a communications port permitting interconnection of the gambling system with another gambling system for exchanging programmed information. Brown (603) does NOT disclose anything approximating a communications port permitting interconnection of the video game system with another video game system for exchanging programmed information. Hillsman, as with Schneier, discloses a variety of communications ports for permitting the biofeedback training and evaluation system to communicate with a variety of peripherals, but does NOT disclose a communications port permitting interconnection of the biofeedback system to another biofeedback system for exchanging programmed information. Bonnett, as with Brown (603), does NOT disclose anything approximating a communications port permitting interconnection of the device with another device for exchanging programmed information.

10.0 The Examiner has rejected claims 35, 36 and 38-42 as obvious over Bonnett (United States Patent No. 4,138,722) in view of Brown (United States Patent No. 5,918,603) in further view of Schneier et al. (United States Patent No. 5,871,398) Knight et al. (United States Patent No. 5,676,551).

SUMMARY OF CITED REFERENCES

Bonnett discloses a device for automatically counting the number of times a smoker inhales upon a tobacco product, such as a cigarette. The device includes a pocket calculator, a pressure sensitive switch and a cigarette holder. The pressure sensitive switch is in fluid communication with the internal chamber of the cigarette holder for detecting a decrease in pressure within the holder caused by a smoker inhaling upon a cigarette positioned within the holder. The pressure sensitive switch is in electrical communication with the pocket calculator for summing and visually displaying the number of detected inhalations.

Brown (603) discloses a video game system programmed with a game which provides a medical patient with therapeutic treatment and/or information for the patient's medical condition. The video game includes a case, an electronic circuit housed within the case, and a speaker for emitting sounds associated with video games (*e.g.*, dings, bells, tones and tunes). Brown further discloses at column 7, lines 10-16 that characters depicted in the video game can communicate instructions and strategies to the patient, but does not specify whether such communication is audible or visual.

Schneier discloses a hand-held, off-line remote gambling system. The device includes a case, a power source, a programmable electronic circuit powered by the power source, a programmable sound synthesizer, and communications ports. The communications ports permit connection to a modem [158], a bar code scanner [152], a printer interface [150a] and printer [150b], a plug-in card interface [154] and a read/write interface [156].

Knight et al discloses a system in which users can ascribe emotional characteristics to a character or characters involved in a simulated interpersonal relationship presented in the form of a motion picture, television program, audio program, computer-generated images, etc.

SUMMARY OF CLAIMED INVENTION

A Fourth Embodiment of the Claimed Invention (claims 33-42) is directed to a portable personality simulator including (i) a case, (ii) a programmable electronic circuit housed within the case, and (iv) a speech synthesizer electrically interconnected to the programmable electronic circuit for issuing commands simulating a particular type of personality.

LEGAL BASIS FOR ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See*, M.P.E.P. § 2143.

PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL OF THE CLAIM LIMITATIONS OF THE CLAIMED INVENTION.

The Fourth Embodiment of the Claimed Invention includes a speech synthesizer for issuing commands simulating a particular type of personality. Bonnett, Brown and Schneier do not disclose a speech synthesizer for issuing commands simulating a particular type of personality. Bonnett is silent as to a speech synthesizer. Brown discloses a speaker for emitting sounds associated with video games (*e.g.*, dings, bells, tones and tunes), but does NOT disclose a speech synthesizer for issuing commands simulating a particular type of personality. Brown does disclose at column 7, lines 10-16 that characters depicted in the video game can communicate instructions and strategies to the patient. However, Brown does not specify whether such communication is audible or visual. Brown discloses at column 4, lines 5-7 that the speaker is effective for "... producing sounds associated with video games ...". Since video games, such as

the SUPER NINTENDO™ system referenced in Brown, generate only simplistic dings, bells, tones and tunes and do NOT generate speech, those skilled in the art are taught by Brown to communicate instructions and strategies by a visual display and NOT by audible speech. Schneier discloses a sound synthesizer, but does NOT disclose a voice synthesizer for issuing commands simulating a particular type of personality. Schneier discloses use of the sound synthesizer to generate game sounds (e.g., dings and bells). Knight et al. discloses ascribing emotional characteristics to simulated characters which will interact with other simulated characters in a motion picture, television program, audio program, computer-generated program, etc. However, Knight et al. does not disclose such characters issuing commands to a user of the system.

CONCLUSION

Applicant respectfully submits that claims 1-4, 6-30 and 32-42 are in condition for allowance.

Respectfully submitted,

Date

30 Jan 04

By

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